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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,571	05/20/2004	Weidong Zhu	266923-000007USPT	6579
70601 7590 04/24/2009 NIXON PEABODY, LLP 161 N. CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213				
EXAMINER				
NGHIEM, MICHAEL P				
ART UNIT		PAPER NUMBER		
2863				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/849,571

**Applicant(s)**

ZHU ET AL.

**Examiner**

MICHAEL P. NGHIEM

**Art Unit**

2863

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 2008 and 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15, 16, 47-54 and 56-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 56-59 is/are allowed.
- 6) ☒ Claim(s) 15, 16, 47-54, 60 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1-15-09, 12-29-08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The Amendments filed on December 29 and 30, 2008 have been acknowledged.

#### ***Information Disclosure Statement***

The information disclosure statement filed on December 29, 2008 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because reference D19, "SD Tools" does not have a publication date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

#### ***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c), filed on December 30, 2008, is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an

earlier filing date under 35 U.S.C. 119(e) as follows: the claim for the benefit of US provisional application 60/471,813, filed December 30, 2008, is not timely.

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable

petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: "60/471,873" (page 1) should be – 60/471,813 --.

### ***Claim Objections***

Claims 47, 49, and 60 are objected to because of the following informalities: before "stiffness parameter" (claim 47, line 11; claim 49, line 9; claim 60, line 10), should insert – said --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 47, 49, and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 47, 49, and 60, why is that when the "number of the stiffness parameters being larger than a number of system equations", "the system equations are severely

underdetermined"? The system equations being severely underdetermined is not understood.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 47, 49, and 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "number of stiffness parameters is larger than a number of system equations such that the system equations are severely underdetermined" is not described in the original disclosure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Weiss et al. (US 2003/0013541).

Regarding claim 15, Weiss et al. discloses a system (Fig. 19) for determining stiffness parameters of a structure (shaft 110, paragraph 0057), comprising:

- a sensor (1877) arranged to measure vibrations of a structure having a lengthwise much greater in magnitude than cross-sectional dimensional thereof (shaft 110's length versus cross-sectional dimensions, Fig. 11) and output to vibration information (paragraph 0116, lines 1-2);

- a stiffness parameter unit (62) for receiving said vibration information (paragraph 0116, lines 1-3), determining natural frequency data or mode shape (vibration frequency, paragraph 0116, lines 4-5; paragraph 0016, lines 6-8) of said structure (paragraph 0116, lines 2-5), and determining the stiffness parameters of said structure using said natural frequency or mode shape data (paragraph 0116, lines 4-5; paragraph 0016, lines 6-8);

- a damage information processor (61) for receiving said stiffness parameters and outputting damage information (data for non-perfect shaft vs. data for perfect shaft displayed via 257, paragraph 0159, lines 18-22, Fig. 25) comprising at least spatial damage information on said structure (symmetry/asymmetry data, paragraph 0160, lines 2-3, represents spatial damage information), said spatial damage information



comprising a damage location along said lengthwise dimension (since the problem of asymmetry is along the length of the elongated member, paragraph 0160, lines 2-4).

Regarding claim 16, Weiss et al. further discloses a damage extent processor (61) for determining extent of damage information (257 shows deviations between data of non-perfect shaft and data of perfect shaft, Fig. 25).

### ***Allowable Subject Matter***

Claims 48, 50-54, 56-59, and 61 are allowed.

### ***Reasons For Allowance***

The **combination** as claimed wherein determining said stiffness parameters using a second or higher order perturbation process (claims 48, 50, 61) or said damage information processor outputting damage location information (claim 51) or a random signal generating unit for generating first and second outputs; a random impact actuator for receiving said first and second outputs; and an impact applicator coupled to said random impact actuator and having an impact region; wherein said random impact actuator drives said impact applicator such that the force and arrival times of said impact applicator at said impact region are random (claim 56) is not disclosed, suggested, or made obvious by the prior art of record.

### ***Response to Amendment***

The amendment filed on December 29&30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: claims 47, 49, and 60, "a number of stiffness parameters is larger than a number of system equations such that the system equations are severely underdetermined".

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

Applicant's arguments filed on December 29&30, 2008 have been fully considered but they are not persuasive.

With respect to the 35 USC 112, 1<sup>st</sup> paragraph, rejection, Applicants argue that claims 47, 49, and 60 have been amended to recite "a number *of stiffness parameters* is larger than a number of system equations". Support can be found in paragraphs [0130] and [0188] (US 2005/0072234). "A system of linear equations is considered over-determined if there are more equations than unknowns, whereas an under-determined system of

linear equations has more unknowns than equations (see, e.g., par. [0188] describing a scenario with a severely underdetermined system).

Examiner's position is that paragraphs [0130] and [0188] describe comparing the system equations with the "m" unknowns (see paragraphs 0130, lines 20-25; paragraph 0188, lines 22-24). However, paragraphs [0130] and [0188] do not disclose comparing the system equations with the stiff parameter (e.g.,  $G_i^{**}(0)$ , paragraph 0130, line 27).

With respect to the 35 USC 102 rejections of claims 15 and 16, Applicants argue that Weiss's method can only give a global stiffness in the circumferential direction and cannot reveal anything about the stiffness along the structure. Weiss does provide teachings relating to symmetry/asymmetry, but these teachings are limited to circumferential symmetry/asymmetry and do not include spatial damage information comprising a damage location along said lengthwise dimension of said structure.

Examiner's position is that Weiss discloses the "asymmetry of golf club shafts can result from nonsymmetrical cross sections (shafts whose cross sections are not round or whose wall thicknesses are not uniform), shafts that are not straight, or shafts whose material properties vary around the circumference of the shaft cross section (paragraph 0007, lines 1-6). Thus, Weiss discloses that the asymmetry of golf club shafts can be along the lengthwise dimension of the structure.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael P. Nghiem/

Primary Examiner, GAU 2863

April 22, 2009